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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/778,325 | 02/07/2001 | Bruce S. Marks | A1019/20268 | 4861 |

3000 7590 07/03/2002

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EXAMINER

NGUYEN, KIMBERLY T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1774

7

DATE MAILED: 07/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

21-6

Office Action Summary

Application No.

09/697,007

Applicant(s)

BOYD ET AL.

Examiner

Kimberly T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4,5,6</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Warning

Applicant is advised that should claim 15 be found allowable, claim 18 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Applicant is advised that should claim 14 be found allowable, claim 16 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-5, and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "sufficient" in the phrase "to provide sufficient porosity" in claim 1 is a relative term which renders the claim indefinite. The term "sufficient" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

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In claims 14-16, it is not clear if the entire film is biaxially oriented or whether one of the layers is biaxially oriented.

Claims 3-5 recite the limitation "said calcium carbonate" in the first line of each claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 11, 14, and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Mauer et al., U.S. Pat. No. 5,800,913.

Mauer shows a white, opaque, biaxially-oriented polyolefin film comprising an outer non-voided layer, a base layer (non-voided internal core layer), at least an inter layer comprising 1-25% by weight of CaCO_3 , and at least a non-voided outer layer (claim 1). Mauer shows that the film is metallized (claim 17).

The phrase "a surface thereof *treated to* receive a metal layer" introduces a process limitation to the product claim in claim 1. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*. Further, process limitations are given no patentable weight in product claims.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-5 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mauer et al., U.S. Pat. No. 5,800,913.

Mauer is relied upon as above for claim 1. Mauer does not show the concentrations of the calcium carbonate as in instant claims 4-5. However, such percentages by weight of the CaCO_3 is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the percentages of weight, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. percentages of weight) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are result effective as they control the opacity, number of voids, and antiblocking functions. As such, they are optimizable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the polyolefin film with the limitations of the percentages by weight since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Mauer does not show that the outer skin layer is oxidatively treated as in instant claims 9-10. Amon shows an opaque polymeric film comprising a film with a plurality of voids and at least one polyolefin skin layer wherein the outer surfaces of the film are treated by oxidation

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(column 7, lines 54-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to treat the outer surfaces of the polyolefin film of Mauer since it is shown by Amon that such a treatment improves surface energy and adhesion of the films to other materials.

The phrase "said opposed outer skin layer is oxidatively treated" introduces a process limitation to the product claims in claims 9 and 10. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*. Further, process limitations are given no patentable weight in product claims.

Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mauer et al., U.S. Pat. No. 5,800,913.

Mauer is relied upon as above for claim 1. Mauer shows that the overall thickness of the film can vary within broad limits and depends on the intended application (column 2, lines 33-52). Though Mauer does not show the exact thicknesses as in instant claims 12-13, such ranges of thicknesses are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the ranges, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. ranges) fails to render claims patentable in the absence of unexpected results. The thickness is result effective as it controls the mechanical strength, opacity, and glossiness (column 1, lines 6-26). As such, they are optimizable. It would have been obvious to one having

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ordinary skill in the art at the time the invention was made to make the film with the thicknesses as shown in instant claims 12-13 since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

The phrase "the outer layer that is *treated to* receive a metal layer" introduces a process limitation to the product claims of 12 and 13. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*. Further, process limitations are given no patentable weight in product claims.

Claims 6-8, 15, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mauer et al., U.S. Pat. No. 5,800,913 in view of Amon, U.S. Pat. No. 6,183,856 B1.

Mauer is relied upon as above for claims 1 and 2. Mauer does not show that the outer skin layer is oxidatively treated as in instant claims 6-8. Amon shows an opaque polymeric film comprising a film with a plurality of voids and at least one polyolefin skin layer wherein the outer surfaces of the film are treated by oxidation (column 7, lines 54-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to treat the outer surfaces of the polyolefin film of Mauer since it is known that such a treatment improves surface energy and adhesion of the films to other materials as shown by Amon (column 7, lines 54-61).

The phrase "said opposed outer skin layer is oxidatively treated" introduces a process limitation to the product claims in claims 6-8. The patentability of a product does not depend on

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its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*. Further, process limitations are given no patentable weight in product claims.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mauer et al., U.S. Pat. No. 5,800,913 in view of Murschall et al., U.S. Pat. No. 5,900,294.

Mauer is relied upon as above for claims 1 and 17. Mauer does not show that the film can be used as a label as in instant claim 20.

Murschall shows a white, opaque label comprising a base layer and at least one outer layer comprising an antiblocking agent such as CaCO_3 (claim 1-7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the film of Mauer as a label since it is known that films of the composition of Mauer and Murschall can be used as label because such films have unusually low heat-sealing temperatures (Murschall, column 7, lines 23-30).

The phrase "said label being intended to be part of a stack of labels for removal...to be applied..." in claim 20 is a recitation of the intended use of the claimed invention. Such a recitation must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Intended use is given little patentable weight in matters of patentability.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly T. Nguyen
Examiner
June 28, 2002

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
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